

REMARKS

As a preliminary matter, the Examiner's withdrawal of claim 44 is respectfully traversed because it merely recites an *additional* feature to the elected embodiment, and is not by itself a distinct embodiment. Accordingly, it is respectfully requested that claim 44 be rejoined and examined as being embodied by the elected embodiment.

With regard to the rejections under § 112, first and second paragraphs, it is respectfully submitted that the enclosed amendment obviates the alleged objections. Accordingly, it is respectfully requested that the rejections be withdrawn.

Claims 15 and 26 are the sole independent claims.

Claim 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ishizaki et al. in view of Chen et al.. This rejection is respectfully traversed for the following reasons.

Claim 15 recites in pertinent part, "the first electrode has a reflectance of 55 % or more with respect to light emitted from the semiconductor multilayer film." The Examiner relies on element 22 of Ishizaki et al. as the claimed first electrode. However, because element 22 is made of gold (*see* paragraph 0113) and the disclosed light-emitting semiconductor of Ishizaki et al. is configured to emit blue light (specified materials of semiconductors, etc.), as would be recognized by one of ordinary skill in the art, the alleged first electrode 22 would have a reflectivity of ~ 40%.

Claim 26 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ishizaki et al. in view of Chen et al. and Iwafuchi et al.. This rejection is respectfully traversed for the following reasons.

Claim 26 recites in pertinent part, "peeling off the first supporting material *from the thick metal film* on the semiconductor multilayer film" (emphasis added). The Examiner admits that Ishizaki et al. in view of Chen et al. does not disclose the claimed first supporting material and therefore relies on elements 13,14 of Iwafuchi et al. as such to modify Ishizaki et al. in view of Chen et al. in an attempt to reach the claimed invention. However, the alleged supporting material 13, 14 of Iwafuchi et al. is used to remove selected diodes 12 from substrate 10 and transfer them onto substrate 18 (see Figures 1-5), whereas the alleged thick metal film 70 of Chen et al. is specifically disclosed to be a non-removed *permanent* substrate for the semiconductor device (see col. 4, line 58). Accordingly, there is no disclosed need or desire to simply attach and remove a supporting material to and from the alleged thick metal film 70 of the proposed combination.

Moreover, the Examiner's alleged motivation for making the modification to the separating process of the proposed combination of Ishizaki et al. in view of Chen et al. (i.e., providing transfers in a short time; see page 11 of outstanding Office Action) is not applicable thereto because the separated substrate of the proposed combination is not being transferred to another substrate, so that the disclosed and simpler separating process of using an excimer laser is the preferred method (see paragraph [0113] of Ishizaki et al.).

In view of the foregoing, it is respectfully submitted that the proposed combinations do not disclose or suggest each and every limitation of the claimed combinations recited in claims 15 and 26. The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejections do not "establish *prima facie* obviousness of [the] claimed invention" as recited in claims 15 and 26 because the proposed combinations fail the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 15 and 26 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on all the foregoing, it is respectfully submitted that the pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 103 be withdrawn.

Further, as it is believed that claim 15 is now in condition for allowance, it is respectfully requested that withdrawn claims 22-25, 30, 40, 41 and 44 be rejoined as depending on an allowable independent claim.

CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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